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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,601	02/26/2004	Maximilian Arzberger	P69484US0	2823

7590 05/13/2005

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EXAMINER
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PETRAVICK, MEREDITH C

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/786,601	ARZBERGER, MAXIMILIAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Meredith C Petravick	3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/16/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

*fw*

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe how the control device has a drive for displacing the cutting elements. Although, the first paragraph on page 3, describes that the control device as being constructed as a hydraulic, rack and pinion or cam control drive. Applicant does not describe how this is attached to the cutting elements or the details of how the control drive works. Therefore, this claim will not be further treated on the merits.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. 4,120,106.

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Discloses a cutting device including:

- a cutting wheel (58)
- first cutting elements (108) for removing soil when the wheel is rotated in a first rotation direction
- second cutting elements (106) for removing soil when the wheel is rotated in a second rotation direction
- a control device (60) for displacing the cutting between a soil removing position and retracted position

Regarding claims 2-3 and 5, the first and second cutting elements are displaceable simultaneously by a force exerted by moving the device against the ground.

Regarding claims 6-8, the control device is a pivoted lever (60) that has a pivot axis (pivot pin 110) and is symmetrical about the pivot axis (Fig. 4).

Regarding claim 9, there is a pair of cutting elements on each pivoted lever (Fig. 4).

Regarding claim 10, the pivoted lever has stops (120, 118).

Regarding claim 11, the cutting elements have cutting edges (Fig. 4).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edno et al. 3,710,878 in view of Smith et al. 4,120,106.

Edno et al. discloses a trench wall cutter with two directly adjacent cutting wheels (14, 15) below a frame. The wheels have cutters (12 and 13), which removed soil when the cutting wheels are rotated in a first direction. However, Edno et al. does not disclose making the cutters have two cutting elements on a control device so one cutting element removes soil when the wheels are rotated in a first direction while the second cutting element is retracted and the second cutting elements removes soil when the cutting wheels are rotated in a direction opposed to the first direction and the first cutting element is retracted.

Like Edno et al., Smith et al. discloses a soil cutting device having a rotating cutting wheel (58) with cutters attached. Unlike Edno et al, Smith et al. discloses providing the cutters with two cutting elements (108 and 106). The cutting elements are attached to a control device (60). The first cutting element (108) removes soil when the wheel is rotated in a first direction while the second cutting element (106) is retracted by the control device (6). The opposite happens when the wheel is rotated in a second direction. Smith et al. discloses that this allows the device is cut in multiple directions without wearing out the not used cutting element (Col. 1, line 60 – Col. 2, line 12).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the cutters of Endo et al. with the cutters of Smith et al., in order to provide for more efficient operation of the device in two directions as suggested in Smith et al.

***Response to Arguments***

7. Applicant's arguments filed 2/16/2005 have been fully considered but they are not persuasive. Applicant amended the preamble of all the pending claims to read "the trench wall cutter" instead of "cutting device." Applicant also added new claims 12 and 13.

Applicant argues that "trench wall cutter" is a term of art that requires a cutting device that is introduced *vertically* into the soil. Applicant states that since the device in Smith et al. is not introduced vertically into the soil it cannot be a trench wall cutter and therefore does not anticipate the claims. Applicant cites patents 5,964,305, 5,924,222, 5,035,071 and 4,834,197 published patent application 2004/023345 and states that since these patents use the term "trench wall cutter" to describe their device and all of the devices are introduced vertically into the soil. The term "trench wall cutter" requires a device to be introduced vertically into the soil.

However, all of the patents cited by Applicant are assigned to the same assignee, Bauer Spezialtiefbau GMBH of Germany. A search for trench wall cutting device show that they do not have to be devices introduced vertically, for example, U.S. Pat. No. 4,312,541. Further, a search of [www.google.com](http://www.google.com) and [www.yahoo.com](http://www.yahoo.com) using the term "trench wall cutter" brings up many devices that cut trenches but not the term "trench wall cutter." Also, a search of the Dictionary of Construction at [www.explore-construction.com](http://www.explore-construction.com) returns no definition for "trench wall cutter." Therefore, contrary to applicant's argument the term "trench wall cutter" does not require that the device be inserted to the soil vertically.

Furthermore, Applicant's claims are structural claims directed to the device and not the method of using the device. Applicant's claim recites no structure of the device that inserts the device into the soil vertically. Therefore, Smith et al. meets all limitations recited in the claims.

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As to the rejection of claim 4 under 35 USC 112, 1<sup>st</sup> paragraph, please see rejection of claim 4 above.

Therefore, all the previously pending claims remain rejected. New claims 12 and 13 are rejected as above.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

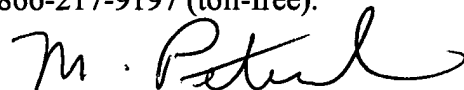
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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meredith C Petravick whose telephone number is 571-272-6995.

The examiner can normally be reached on M-T 8:00 a.m.- 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Meredith C Petravick  
Primary Examiner  
Art Unit 3671

May 11, 2005